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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

PATENT APPLICATION

Inventors: Chris C. Angus; Bruce B. Ottmann

Art Unit:

SC/Serial No.: 09/269,624

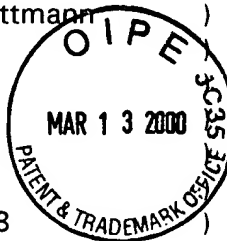
Filed: March 30, 1999

Examiner:

PCT Application No.: PCT/GB98/03440

Filed: November 16, 1998

Title: DATA PROCESSING SYSTEM



V.W.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited in the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on March 10, 2000.

Warren S. Wolfeld

(Attorney Signature)

Warren S. Wolfeld, Reg. No.: 31,454

Signature Date: March 10, 2000

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.56

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

It is requested that the information identified in this statement be considered by the Examiner and made of record in the above-identified application. This statement is not intended to represent that a search has been made or that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56.

Enclosed with this statement are the following:

- X Form PTO-1449. The Examiner is requested to initial the form and return it to the undersigned in accordance with M.P.E.P. § 609.
- X REMARKS, referenced in the Form PTO-1449.

This statement should be considered because:

X This statement qualifies under 37 C.F.R. §1.97, subsection (b) because:

- (1) It is being filed within 3 months of the application filing date;
-- OR --
- (2) It is being filed within 3 months of entry of a national stage;
-- OR --
- (3) It is being filed before the mailing date of the first Office action on the merits,
whichever occurs last.

___ Although it may not qualify under subsection (b), this statement qualifies under 37 C.F.R. §1.97, subsection (c) because:

- (1) It is being filed before the mailing date of a FINAL Office Action and before a Notice of Allowance (whichever occurs first)

-- AND (check at least one of the following) --

- ___ (1) It is accompanied by the \$240 fee set forth in 37 C.F.R. §1.17(p)
-- OR --
- ___ (2) It is accompanied by a STATEMENT as set forth in 37 C.F.R. §1.97(e)

___ Although it may not qualify under subsection (b) or (c), this statement qualifies under 37 C.F.R. §1.97, subsection (d) because:

- (1) It is accompanied by a STATEMENT as set forth in 37 C.F.R. §1.97(e);
-- AND --
- (2) It is accompanied by a PETITION TO ACCEPT INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97(d);
-- AND --
- (3) It is accompanied by the \$130 fee set forth in 37 C.F.R. §1.17(i)(1);
-- AND --
- (4) The Issue Fee has not yet been paid.

X **Fee Authorization.** The Commissioner is hereby authorized to charge underpayment of any additional fees or credit any overpayment associated with this communication to Deposit Account No. 06-1325. A duplicate copy of this authorization is enclosed.

Respectfully submitted,

FLIESLER, DUBB, MEYER & LOVEJOY LLP

Date: 3/10/00

By: Warren S. Wolfeld
Warren S. Wolfeld
Reg. No. 31,454

REMARKS

The following Remarks are supplied as part of or in supplement to this Information Disclosure Statement.

ON SALE/PUBLIC USE

The critical date for the present National Stage patent application, for the purposes of the one year on-sale and public-use bars, is believed to be September 4, 1997, which is one year before the filing date of the priority U.K. patent application. Nevertheless, this disclosure is written as if the critical date is November 16, 1997, which is one year before the filing date of the intervening PCT application.

The invention was included in a software system that was developed in the U.K. by Shell International Petroleum Company Ltd (SIPC). A prototype of the software was delivered from one division of SIPC to another, which used it experimentally prior to the critical date in several countries but always outside the U.S. Both divisions of SIPC were at that time part of a single company.

A beta of Version 1 of the software was delivered to the Shell Company of Australia Ltd and to A/S Norske Shell, in Australia and Norway respectively, also prior to the critical date. These groups were wholly owned subsidiaries (country operating companies) of SIPC.

SIPC adopted the software for global rollout, solely within SIPC, also prior to the critical date.

It was not until after the critical date that Shell Services International (SSI), the assignee of the present patent application, was formed as a wholly owned subsidiary of Royal Dutch/Shell Group of Companies. The rights to the software were assigned after the critical date to SSI.

All uses of the software prior to the critical date took place outside the United States and took place privately within SIPC. The uses of the software within SIPC included post-sale management reporting of information, all data being entered into the system at or subsequent to the point of sale. All uses of the software prior to the critical date were confidential within SIPC.

The Facts Do Not Indicate "On Sale" Activity Prior To The Critical Date

35 U.S.C. §102(b) bars issuance of a patent if "the invention was ... in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States"

It is submitted that none of the activities described above which took place prior to the critical date constitute an "on sale" bar because all the activities took place within a single entity, SIPC. It is submitted that an invention cannot be considered "on sale" if no entity other than the owner of the invention is involved.

It is submitted that none of the activities described above which took place prior to the critical date constitute an "on sale" bar also because all the activities took place outside the United States.

The Facts Do Not Indicate "Public Use" Activity Prior To The Critical Date

Nor do any of the activities described above which took place prior to the critical date constitute a "public use" bar, because all such activities took place within the single entity and took place in a non-public manner. In addition, all such activities took place outside the United States.

Nor were any methods of the software used prior to the critical date in making any product that was sold outside SIPC. Although the various divisions and wholly owned subsidiaries of SIPC were selling various products at the time that SIPC was using the software, as mentioned, the software was not, prior to the critical date, used in any activity involving data developed prior to the sale of product. The software could not, therefore, have been used prior to the critical date in the making of any product to sell.

Accordingly, it is submitted that the facts described herein do not give rise to a bar to patentability under 35 U.S.C. §102(b).

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